

### **REMARKS**

Claims 1-6, 11-89 are pending in the patent application. Claims 7, 13, 14, 16, 21, 30-32, 34, 37, 41-48, 57, 58, 60-64, 66, 67, 71-78, 81-86, and 88 are withdrawn. Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected in the Office Action mailed on January 31, 2008.

In the claims, the term “adapted to” has been amended to recite “configured to” based on the Examiner’s general objection to the language “adapted to” and preference for the phrase “configured to.” Because such amendments do not change to scope of the claims, the claims have been so amended.

### **35 U.S.C. § 103 Rejection**

In the non-final Office Action dated January 31, 2008, claims 1, 5, 6, 11, 15, 17-20, 22-24, 33-36, 38-40, 49, 56, 59, 65, 68-70, 79, 80, 87 and 89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,790,697 to Munro et al. (“Munro”) in view of U.S. Patent No. 5,290,033 to Bittner et al. (“Bittner”).

As pointed out in the Applicants’ prior responses, one basic requirement for a *prima facie* case of obviousness under § 103(a) is that the prior art references must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Munro in view of Bittner does not satisfy this test, because the applied references fail to disclose an input receptacle that receives a stack of a mixed combination of both currency bills and documents of another type, as recited by independent claims 1, 11, 56, 79, 87, and 89. Moreover, the applied references fail to disclose a processing module or a transport mechanism that receives the currency bills and the documents of another type from the stack in the input receptacle, as further recited by the independent claims. Accordingly, the Office Action fails to establish a *prima facie* case of obviousness, and the rejection must be withdrawn.

In particular, independent claim 1 recites “an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds” and “a processing module coupled to the input receptacle and configured to receive the currency bills and substitute funds from the stack in the input receptacle and to process the currency bills and substitute funds.” (emphases added.)

Independent claim 11 recites “an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media” and “a transport mechanism

configured to transport the currency bills and substitute currency media, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path.” (emphases added.)

Independent claim 56 recites “an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media” and “a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path.” (emphases added.)

Independent claim 79 recites “an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media” and “a transport mechanism configured to transport the currency bills and barcoded media, one at a time, from the stack in the input receptacle to one of the plurality of output receptacles.” (emphases added.)

Independent claim 87 recites “an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, the substitute currency media being redeemable documents” and “a transport mechanism configured to transport the documents, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path.” (emphases added.)

Independent claim 89 recites “an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents” and “a transport mechanism for transporting the currency bills and redeemable documents, one at a time, from the stack in the input receptacle to selected ones of the plurality of output receptacles along a transport path.” (emphases added.)

The Office Action asserts that “Munro discloses a document processing apparatus (10) that processes stacks of currency placed in an input receptacle (12) in mixed denominations . . . .” (Office Action, p. 3, ll. 4-6.) According to the Office Action’s reading, Munro only discloses an input receptacle receiving stacks of currency bills and fails to teach or suggest an input receptacle that receives a mixed combination of both currency bills and documents of another type. Indeed, the Office Action concedes that “Munro does not expressly disclose . . . processing both barcoded documents as well as paper currency.” (Office Action, p. 3, ll. 19-22.)

According to the Office Action, however, “Bittner discloses an evaluation unit (226) having both a validator/discriminator and a barcode reader (222), for the purpose of processing both barcoded documents as well as paper currency.” (Office Action, p. 3, ll. 19-22.) Bittner, however, fails to disclose an input receptacle that receives a stack of a mixed combination of barcoded documents and paper currency. Rather, as shown in FIGS. 8 and 10-11, Bittner discloses a gaming machine 200 that requires a bezel 215 with “both a currency entry 240 and a game coupon entry 242.” (Bittner, col. 7, ll. 42-43.) With respect to the currency entry 240, Bittner states:

Currency entry 240 comprises a tapered opening extending the full width of receiving throat 236. Currency entry 240 accepts currency from a player and guides it into bill validator 222. Currency entry 240 is aligned so that currency is routed horizontally into receiving throat 236. FIG. 10 shows currency 244 being received through currency entry 240 into bill validator 222.

(Bittner, col. 7, ll. 44-49, emphases added.) Meanwhile, with respect to the game coupon entry 242, Bittner states:

Bill validator 222 also accepts game coupons, through coupon entry 242. Coupon entry 242 has a width which corresponds to the width of a game coupon, generally less than the width of receiving throat 236. Coupon entry 242 accepts game coupons such as game coupon 248 shown in FIG. 11, and guides them into bill validator 222 beneath code reader 224. Coupon entry 242 is above currency entry 240, and is downwardly inclined to guide game coupons into the horizontally-extending receiving throat 236.

(Bittner, col. 7, l. 66-col. 8, l. 7, emphasis added.) Bittner also explains that “[g]ame coupons are inserted into coupon entry 242, which aligns them along the left-hand edge of throat 236.” (Bittner, col. 8, ll. 13-15, emphasis added.) Therefore, according to Bittner, a player is required to determine manually whether a document is a currency bill or a game coupon and to insert the document manually into the appropriate entry 240 or 242 so that the document may be properly aligned and guided for processing. Because the documents must be sorted manually before they are introduced into the machine 200 via the currency entry 240 or the coupon entry 242, the machine 200 does not process or transport documents from a stack of mixed currency bills and game coupons in an input receptacle, as required by the claims. Indeed, because Bittner discloses a manual process that requires documents to be inserted into the machine one at a time, the machine 200 cannot accommodate documents received as a stack in the input receptacle.

Accordingly, because neither Munro nor Bittner discloses an input receptacle that receives a stack of a mixed combination of currency bills and documents of another type, the references fail to

teach or suggest each and every element of the independent claims and thus cannot provide sufficient grounds for establishing a *prima facie* case of obviousness.

Furthermore, as M.P.E.P. § 2143.02 I. explains, “[t]he prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.” In addition, M.P.E.P. § 2143.02 II. further provides that “at least some degree of predictability is required” and “evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.” Applicants respectfully submit that the application of Munro and Bittner also fail to establish a *prima facie* case of obviousness, because there is no evidence that the results of combining Munro and Bittner would be sufficiently predictable to produce the inventions claimed by independent claims 1, 11, 56, 79, 87, and 89.

The Office Action asserts that “it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in Munro’s evaluation device for the purpose of handling barcoded documents placed in the same stack of documents as paper currency.” (Office Action, p. 4, ll. 1-4.) However, assuming that the barcode reader of Bittner could be incorporated in Munro’s evaluation device as suggested in the Office Action, Bittner actually teaches that successful operation of the barcode reader also requires implementing “both a currency entry 240 and a game coupon entry 242,” so that the barcoded documents can be properly aligned and guided by the game coupon entry 242 for processing by the barcode reader. (Bittner, col. 7, ll. 42-43; col. 8, ll. 13-15.) As discussed previously, the use of the currency entry 240 and the game coupon entry 242 to input single documents manually into the machine precludes the use of an input receptacle that receives a stack of a mixed combination of documents. There is no evidence that either Munro or Bittner provide any indication that barcoded documents can be mixed within a stack of currency bills in an input receptacle and subsequently separated and aligned for processing with the barcode reader, especially in light of Bittner which calls for manually separating and inputting single documents.

In view of the foregoing, Applicants respectfully submit that independent claims 1, 11, 56, 79, 87, and 89 are allowable over Munro and Bittner. In addition, dependent claims 5, 6, 15, 17-20, 22-24, 33-36, 38-40, 49, 59, 65, 68-70, and 80 are also allowable at least for the same reasons as base claims 1, 11, 56, and 79.

## **Double Patenting Rejections**

### **A. Tests of Double Patenting**

The Federal Circuit has defined the tests of double patenting as follows:

Is the same invention being claimed twice? If the answer to that is no, a second question must be asked: Does any claim in the application define merely an obvious variation of an invention claimed in the patent asserted as supporting double patenting? If the answer to that is no, *there is no double patenting*.

*General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278, 23 U.S.P.Q.2d 1839 (Fed. Cir.), *reh'g, en banc, denied*, 1992 U.S. App. LEXIS 25713 (Fed. Cir. Oct. 5, 1992) (emphasis added); *In re Kaplan*, 789 F.2d 1574, 1579, 229 U.S.P.Q. 678 (Fed. Cir. 1986); *In re Longi*, 759 F.2d 887, 893, 225 U.S.P.Q. 645 (Fed. Cir. 1985) (“we must direct our inquiry to whether the claimed invention in the application for the second patent would have been obvious from the subject matter of the claims in the first patent, in light of the prior art”). The Federal Circuit further went on to explain the connection between obvious variation and patentable distinction stating “If the rejected claim defines *more* than an obvious variation, it is *patentably distinct*.” *General Foods*, 972 F.2d at 1278 (emphasis in original). Moreover, the Federal Circuit stated “beyond question ... the determining factor in deciding whether or not there is double patenting is the existence vel non of *patentable difference* between two sets of claims.” *General Foods*, 972 F.2d at 1278-79 (emphasis in original); *see also In re Sarett*, 327 F.2d 1005, 1012, 140 U.S.P.Q. 474 (C.C.P.A. 1964). Furthermore, “where the two inventions are *patentably distinct*, no disclaimer is called for.” *General Foods*, 972 F.2d at 1280.

### **B. Double Patenting Assessed Based on Claims**

The law is clear that it is the *claims* that must be compared when assessing double patenting. *General Foods*, 972 F.2d at 1277 (“Double patenting is altogether a matter of what is claimed”); *In re Sarett*, 327 F.2d at 1007; *In re Allen*, 343 F.2d 482, 484, 145 U.S.P.Q. 147 (C.C.P.A. 1965). Furthermore, claims must be read as a whole taking into account every limitation. *General Foods*, 972 F.2d at 1278; *Id.* at 1281 (“the fundamental rule of claim construction, that what is claimed is *defined by the claim taken as a whole*, every claim limitation ... being material”) (emphasis in original). Furthermore, the focus is on what the claims *define*, not what they might teach. *In re*

*Sarett*, 327 F.2d at 1013 (“We are not here concerned with what one skilled in the art would be aware from *reading* the claims but with *what inventions the claims define*”) (emphasis in original); *In re Sutherland*, 347 F.2d 1009, 1014, 146 U.S.P.Q. 485 (C.C.P.A. 1965) (“The ‘scope’ of the term ‘freezing’ in [the patent’s] claims is not what we are concerned with but rather, *what invention* his claims *define*”) (emphasis in original).

In this regard, it must be remembered that the disclosure of the prior patent is not prior art. *In re Baird*, 348 F.2d 974, 979, 146 U.S.P.Q. 579 (C.C.P.A. 1965) (“the patent disclosure is not ‘prior art’ and cannot be looked to for what it teaches”); *In re Sarett*, 327 F.2d at 1007. This includes the disclosure of the claims themselves. *In re Sutherland*, 347 F.2d at 1015; *General Foods*, 972 F.2d at 1281. Accordingly, the patent’s specification “may be looked to to find out what the terms of the claims *mean* but that is all.” *In re Baird*, 348 F.2d at 979-80; *In re Kaplan*, 789 F.2d at 1577 (“We reverse the board’s double patenting rejection essentially for two reasons: ... (2) it has used the disclosure of appellants’ joint invention in the Kaplan patent specification as though it were prior art, which it is not, to support the obviousness aspect of the rejection”).

### **C. Old Obviousness-Type Double Patenting Rejections [1] – [6]**

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-73 of U.S. Patent No. 6,880,692 [1], claims 1-78 of U.S. Patent No. 6,913,130 [2], claims 1-91 of U.S. Patent No. 6,959,800 [3], claims 1-31 of U.S. Patent No. 6,955,253 [4], or claims 1-26 of U.S. Patent No. 6,868,954 [5] in view of Bittner. In addition, claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-29, 78-89, and 146-149 of copending Application No. 09/684,103 [6] in view of Bittner. Applicants respectfully traverse these rejections and respectfully request the withdrawal of such rejections because the claims of each of the cited patents/application have elements that are not present in any of the rejected claims of the present application and/or vice versa. Applicants maintain their arguments to these rejections which were presented in the Amendment in Response to Final Office Action, filed on June 18, 2007, the contents of which are

incorporated herein by reference. In particular, the arguments present differences between the elements of the present claims and the cited claims.

The Office Action also concedes that “not all of the claims may have recited a ‘barcode reader’ that reads substitute currency.” (Office Action, p. 8, ll. 16-17; p. 10, ll. 8-9.) However, to cure the deficiencies in U.S. Patent No.’s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103, the Office Action applies Bittner as a secondary reference. In particular, similar to the rejection under § 103(a), the Office Action asserts that “[a]t the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated a barcode reader in the currency processing device of [the cited patents and the copending application] for the purpose of handling barcoded documents placed in the same stack of documents as paper currency.” (Office Action, p. 8, l. 21-p. 9, l. 2; p. 10, ll. 13-16.) However, this argument misses the mark. The issue is whether the pending claims *claim* inventions which are obvious variant of *what is claimed* in another patent. As described in the prior responses, such is not the case.

Furthermore, as described previously, the barcode reader of Bittner is not combinable with a device that receives a stack of currency bills via an input receptacle. Bittner requires a process by which barcoded documents can be properly aligned and guided for processing by the barcode reader, but the only teaching in this regard involves manually separating and inputting single documents into a currency entry 240 and a game coupon entry 242. (See Bittner, col. 7, ll. 42-43; col. 7, l. 66-col. 8, l. 7; col. 8, ll. 13-15.) Bittner’s use of separate entries 240 and 242 and its use of manual feeding of documents, one document at a time, into the device of Bittner, teaches away from the use of “an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds” as recited in independent claims 1 and 11, “an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media” as recited in independent claim 56, “an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media” as recited in independent claim 79, “an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media” as recited in independent claim 87, and “an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents” as recited in

independent claim 89. Accordingly, independent claims 1, 11, 56, 79, 87, and 89 are patentably distinct. In addition, dependent claims 5, 6, 15, 17-20, 22-24, 33-36, 38-40, 49, 59, 65, 68-70, and 80 are also distinguishable at least for the same reasons as their corresponding independent claims.

Furthermore, there is no teaching or other evidence that the barcode reader of Bittner could operate at a high rate of speed in the systems recited in claim 5 and 6 or the apparatus of claims 23-24. Therefore, it would not have been obvious to modify U.S. Patent No.'s 6,880,692, 6,913,130, 6,959,800, 6,955,253, and 6,868,954 and Application No. 09/684,103 with the teachings of Bittner.

#### **D. New Obviousness-Type Double Patenting Rejections [7] – [11]**

Claims 1-6, 11, 12, 15, 17-20, 22-29, 33, 35, 36, 38-40, 49-56, 59, 65, 68-70, 79, 80, 87, and 89 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 13, 25, 26, 37, and 49 of U.S. Patent No. 7,103,438 [7]; claims 1 and 6 of U.S. Patent No. 7,201,320 [8]; claims 1-69 of U.S. Patent No. 6,843,418 [9], claims 1-24 of U.S. Patent No. 7,146,245 [10] or claims 14, 19, 20, 31, and 41-47 of U.S. Patent No. 7,016,767 [11].

With respect to U.S. Patent No.'s 7,103,438; 6,843,418; 7,146,245; and 7,016,767, Applicant respectfully traverses these rejections and requests reconsideration of the rejections in view of the amendments and remarks presented herein including those made above with respect to Obviousness-Type Double Patenting Rejections [1] – [6].

[7] Turning to U.S. Patent No. 7,103,438, claims 1, 5, 13, 25, 26, 37, and 49 of U.S. Patent No. 7,103,438 differ from the rejected claims of the present application. To begin with, claims 1 and 5 of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims as described in Applicants' prior responses. Furthermore, independent claim 1 of U.S. Patent No. 7,103,438 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

accepting as an input at least one specific document-identifier to be searched; ...

determining whether a detected document-identifier matches the at least one specific document-identifier; and



directing the substitute currency medium that bears the specific document-identifier, such substitute currency medium being termed a specific document, to at least one output receptacle based on the act of determining.

Independent claim 13 of U.S. Patent No. 7,103,438 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

the controller including a memory, the memory storing instructions that determine whether a detected document-identifier matches a specific document-identifier received as an input by said controller.

Finally, the last independent of U.S. Patent No. 7,103,438 cited is independent claim 37 which recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

the controller including a memory that stores a stack-identifier assigned to said first stack of documents, the memory including the document-identifier of each of the documents comprising the first stack of documents, each document-identifier being correlated with a respective stack-identifier, the memory further including instructions for determining whether a specific document-identifier inputted into said controller is located within said first stack of documents.

Additionally, the rejected claims of the present application also have patentably distinct element(s) that are not present in the cited claims of U.S. Patent No. 7,103,438. For example, independent claim 1 recites, *inter alia*:

an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute funds;  
a processing module coupled to the input receptacle and configured to receive the currency bills and substitute funds from the stack in the input receptacle and to process the currency bills and substitute funds, the processing module being configured to distinguish currency bills from substitute funds and valid substitute funds from invalid substitute funds

Likewise, independent claim 11 recites, *inter alia*:

an input receptacle configured to receive a stack of a mixed combination of currency bills and substitute currency media;  
at least one output receptacle configured to receive currency bills and substitute currency media after the currency bills and substitute currency media have been evaluated;  
a transport mechanism configured to transport the currency bills and substitute currency media, one at a time, from the stack in the input receptacle to the at least one output receptacle along a transport path;  
an evaluation unit comprising at least one currency detector disposed along the transport path between the input receptacle and the output receptacle, the at least one currency detector being capable of evaluating currency bills,

... the evaluating unit being configured to distinguish currency bills from substitute currency media

Likewise, independent claim 56 recites, *inter alia*:

- an input receptacle configured to receive a stack of documents, the documents including a mixed combination of currency bills and barcoded media; ...
- an evaluation unit including a first sensor disposed along the transport path between the input receptacle and the output receptacle, the first sensor being configured to detect at least one characteristic of a currency bill,

Likewise, independent claim 79 recites, *inter alia*:

- an input receptacle configured to receive a stack of documents including a mixed combination of currency bills of mixed denominations and barcoded media; ...
- a transport mechanism configured to transport the currency bills and barcoded media, one at a time, from the stack in the input receptacle to one of the plurality of output receptacles;
- an evaluation unit disposed along the transport path between the input receptacle and the plurality of output receptacles, the evaluation unit comprising at least one currency sensor ... positioned adjacent the transport path, the at least one currency sensor being configured to obtain denomination characteristic information of a first currency bill,...
- a controller coupled to the evaluation unit, the controller being programmable for directing currency bills having a first denomination to a specified first output receptacle of the plurality of output receptacles, ... and
- a memory electrically coupled to the controller, the memory being configured to store the denominations of the currency bills ....

Independent claim 87 recites, *inter alia*:

- an input receptacle configured to receive a stack of documents including a mixed combination of currency bills and substitute currency media, ...
- an evaluation unit comprising a first scanner disposed along the transport path between the input receptacle and the output receptacle, the first scanner being capable of scanning for at least one characteristic associated with a currency bill, ... the evaluating unit being configured to distinguish currency bills from substitute currency media and to distinguish valid substitute currency media from invalid substitute currency media; ....

And finally, independent claim 89 recites, *inter alia*:

- an input receptacle for receiving a stack of a mixed combination of currency bills and redeemable documents;

- a plurality of output receptacles for receiving currency bills and redeemable documents after the currency bills and the redeemable documents have been evaluated;
- a transport mechanism for transporting the currency bills and redeemable documents, one at a time, from the stack in the input receptacle to selected ones of the plurality of output receptacles along a transport path;
- an evaluation unit comprising a detector disposed along the transport path between the input receptacle and the output receptacle, the detector being configured to detect characteristic information associated with a currency bill and characteristic information associated with a redeemable document, the evaluating unit being configured to distinguish currency bills from redeemable documents and to distinguish valid redeemable documents from invalid redeemable documents....

[8] Turning to U.S. Patent No. 7,201,320, claims 1 and 6 of U.S. Patent No. 7,201,320 differ from the rejected claims of the present application. Claim 6 is dependent on claim 1. Independent claim 1 of U.S. Patent No. 7,201,320 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

- at least one imager for capturing an image of at least a portion of the substitute currency media and the currency bills, wherein the imager creates an image file from the captured image; and
- a controller for controlling the at least one media detector, currency detector and imager, wherein the controller further receives the image file and processes the image file for storage.

[9] Turning to U.S. Patent No. 6,843,418, claims 1-69 of U.S. Patent No. 6,843,418 differ from the rejected claims of the present application. To begin with, claims 51-69 of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims as described in Applicants' prior responses.

Additionally, as an example, independent claim 1 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

- at least one of the substitute currency media having at least a first barcode pattern and a second barcode pattern disposed thereon; ...
- an evaluation unit comprising ... a first media detector ... being capable of detecting the first barcode pattern and the second barcode pattern ....

As an additional example independent claim 24 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

at least one of the substitute currency media including at least a first barcode pattern representative of a ticket number and a second barcode pattern representative of a value ...;

an evaluation unit comprising ... a first media detector ... being capable of detecting the first barcode pattern and the second barcode pattern; ...

a communications port coupled to the controller, the communications port being adapted to transmit at least one of the ticket number associated with the first barcode pattern and the value associated with the second barcode pattern.

As an additional example independent claim 27 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

each of the substitute currency media including at least a first barcode pattern encoding a number and a second barcode pattern encoding a value associated with the number; ...

an evaluation unit comprising at least one detector ... capable of ... decoding the number encoded in the first barcode pattern and the value encoded in the second barcode pattern on each of the substitute currency media, one of the substitute currency media on which a number and a value are decoded being termed a valid substitute currency medium, and a controller ... including a memory, the memory being adapted to store the number and the value of each valid substitute currency medium decoded by the detector.

As an additional example independent claim 47 of U.S. Patent No. 6,843,418 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

47. A document processing device in a system having a plurality of machines adapted to accept documents, the plurality of machines being coupled to an accounting system, the document processing device comprising: ... each of the substitute currency media including at least a first barcode pattern encoding a number and a second barcode pattern encoding a value; ...

an evaluation unit comprising at least one detector ... capable of ... decoding the number encoded in the first barcode pattern and the value encoded in the second barcode pattern on each of the substitute currency media, and a controller ... being adapted to store the number and the value of each substitute currency medium to a file.

[10] Turning to U.S. Patent No. 7,146,245, claims 1-24 of U.S. Patent No. 7,146,245 differ from the rejected claims of the present application. To begin with, claims 1-24 of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims as described in Applicants' prior responses. Additionally, as an example independent claim 1 of U.S. Patent No. 7,146,245 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

1. A method of processing at least two batches of documents, comprising the acts of:
  - receiving the at least two batches of documents;
  - entering into memory of a document processing device source identification information for the at least two batches in a sequence;
  - loading the at least two batches into the document processing device for multiple batch processing in a sequence consistent with the sequence in which the source identification information was entered into memory;
  - after entering the source identification information for the at least two batches into memory, begin transporting the batches in a sequence consistent with the sequence in which the source identification information was entered into memory, one document at a time, through the document processing device to obtain characteristic information from the documents in the at least two batches, pausing the transport between each batch;
  - determining the batch information for each of the at least two batches based on the obtained characteristic information; and
  - matching on a sequential basis the batch information for each of the at least two batches with the source identification information for each of the at least two batches.

[11] Turning to U.S. Patent No. 7,016,767, claims 14, 19, 20, 31, and 41-47 of U.S. Patent No. 7,016,767 differ from the rejected claims of the present application. To begin with, claims 14, 19, 20, and 31 of this patent are method claims; and thus, the rejection is improper given the finding that the method claims of the present application are patentably distinct from the rejected apparatus/system claims as described in Applicants' prior responses.

Additionally, as an example, independent claim 14 of U.S. Patent No. 7,016,767 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

14. A method of processing at least two batches of documents, comprising the acts of:

loading the at least two batches into a document processing device for multiple batch processing;  
starting transportation of the batches in a sequence, ...  
after the act of determining batch information for each of the at least two batches, entering source identification for each batch into memory in a sequence consistent with the sequence in which the at least two batches were transported through the document processing device; and  
matching on a sequential basis the batch information for each of the at least two batches with the source identification information for each of the at least two batches.

As another example, independent claim 41 of U.S. Patent No. 7,016,767 recites patentably distinct element(s) that are not recited in the presently rejected claims such as:

41. A document processing device for multiple batch processing comprising:  
an input receptacle adapted to hold at least two batches of documents; ...  
memory coupled to the evaluation unit adapted to store batch document information for each of the at least two batches based on processing the documents, and being adapted to store source identification information for each of the at least two batches;  
a bar code gun coupled to the memory for entering the source identification information into memory; and  
a controller coupled to the memory and comprising programming for:  
allowing the source identification information for the at least two batches to be entered into memory before the at least two batches are transported past the evaluation unit, and sequentially stepping through the source identification information stored in memory to match batch document information with source identification information.

Accordingly, Applicants respectfully request that the double patenting rejections be withdrawn.

**Conclusion**

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. No fees are believed due with this paper. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000305USP1. Should there be any remaining matters, Applicants invite the Examiner to call the attorney below so that such matters may be resolved expeditiously.

Dated: September 26, 2008

Respectfully submitted,

By /Paul R. Kitch/

Paul R. Kitch

Registration No.: 38,206

NIXON PEABODY LLP

161 N. Clark St., 48<sup>th</sup> Floor

Chicago, Illinois 60601

(312) 425-3900

Attorneys For Applicant